# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/559,778 | 04/27/2000 | Elliott D. Light | 2249 | 2634 |

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| 7590 11/19/2003 | | EXAMINER |
| Roberts Abokhair & Mardula LLC | | ZURITA, JAMES H |
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3625 | |

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DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | **Application No.** | | **Applicant(s)** |
|---|---|---|---|
| **Office Action Summary** | 09/559,778 | | LIGHT ET AL. |
| | **Examiner** | | **Art Unit** |
| | James Zurita | | 3625 |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>03 September 2003</u> .

2a)☒ This action is **FINAL**.     2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>80-115</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>80-115</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

## DETAILED ACTION

### *Response to Amendment*

A First Office Action of June 18 2003 rejected claims 1-79. By Amendment A of

3 September 2003, applicant cancelled claims 1-79 and added claims 80-115.

Claims 80-115 are pending and will be examined.

### *Priority*

The Examiner respectfully acknowledges applicant's claim to priority to

Application 09/167873, filed 7 October 1998, issued on 18 July 2000 as US Patent

6,092,053.

In order to clarify the record, the Examiner respectfully requests the Applicant

identify where in the prior applications the features of the present invention are first

disclosed. It is not clear whether applicant has introduced and claims patentable

distinction. For example, In the priority document, applicant refers to customers (in

the specification), consumers (in the claims) and merchants. In the instant application

customer/ consumer is a "data subject" and merchant is a "data recipient." It is not

clear whether applicant has introduced and claims patentable distinction.

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Claims 80-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Peckover (US 6,119,101) in view of Walker (US Patent 5794207).

The term *data repository* will be given its broadest reasonable interpretation to

mean a collection of information about a computing system[1] such as a database and

database management software (data repository software). Peckover discloses the use

of collections of information about his computing systems.[2] See, for example,

references to databases and collections of information concerning object server, agent

system, agent managers and others, Figs. 1-10 and related text.

The descriptive material (for example, "data subject", "data recipient", "network

communication device") does not distinguish the claimed invention from the prior art in

terms of patentability. For purposes of applying prior art the term "data subject" will be

interpreted to read on patrons, buyers, clients, shoppers, purchasers, users,

consumers, consumers, a party to a transaction, etc. The term "data recipient" will be

interpreted to read on merchants, sellers, providers, users, a party to a transaction, etc.

The terms "network communication device" will be interpreted to read on any

type of device that might be used to connect a client node to a network in a client/server

network architecture. The types of clients may include personal computers,

workstations, telephones, dumb and intelligent programmable devices, wireless

devices, PDA's. Users on client machines may use a client to search in or access

server databases, select, search, request searches, download files and information, and

generally interact with one or more servers on a network.

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[1] Definition of Repository, MICROSOFT Computer Dictionary.

The term "network communication device software" will be interpreted to read on any client-side software that identifies a client node to server-side software on a network, such as a cookie. See, for example, Col. 6, lines 26-32.

Please note that Peckover discloses that a party may alter roles and that a party may invoke transactions. Peckover discloses at least the following:

Manage persistence – includes hardware and software that manage storage such as one would find in data repositories such as databases). Data stored may be gathered by the system (for example, Col. 25, line 35-Col. 26, line 38, Fig. 9A-9C and related text). See also references to system history data Fig. 2 and related text Fig, 3B for persistence functions, which manage data repository functions for various objects in Peckover's system. For client-side persistence, Peckover discloses the use of cookies (for example, See, for example, Col. 6, lines 26-32). A server may check a cookie against a database to verify whether a customer is registered, using well-known techniques.

Manage communications and messages including hardware and software that (a) connect the parties to the network and each other (b) manage access (authorization and registration) to computer systems and sub-system (c) send and receive data among various parties at one or more network nodes. Peckover discloses the use of unique identification numbers (for example, Col. 18, line 30-Col. 19, line 32) and passwords (applicant's passphrase) for example, Fig. 11 and related text, Col. 27, line 50-Col. 28, line 49).

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[2] Definition of Repository, MICROSOFT Computer Dictionary.

Manage interactions over networks such as the Internet (for example, Col. 5, line

12-52), cable, satellite links and others (for example, Col. 38, line 53-67).

Manage client/server functions – includes hardware and software related to

Human/Machine interfaces, using computer languages such as HTML (for example,

Col. 8, line 9-67). See also references to browser software usable on each party's

machine (applicant's network communication device software). When invoked,

browsers perform a party's client-side activity such as translating information to/from

different native computer languages, send and receive information to/from other nodes

on various networks. Browsers permit users to interact with networks and each other.

Manage logging, gather and store transaction information (for example, Col. 15,

line 10-63). See also references to log functions, whereby Peckover stores records of

activities (claims 88, 90 and related medium and system claims), and transactions for

each party as in Fig. 6 and related text, Col. 21, line 13-67, Fig. 7 and related text, Col.

22, line 1-54. See also query loggers, Historical demand, previous transactions. For

example, Col. 24, line 62-Col. 25, line 34.

Peckover discloses that users may be authorized users and registered users.

Peckover permits persons and organization to become registered users. For example,

Col. 18, line 30-Col. 19, line 52. Peckover permits persons and organization to become

authorized users. For example, see Col. 21, line 13-67, Col. 25, lines 1-32.

Peckover discloses that parties may alternatively initiate offers and accept offers

as electronic transactions over one or more networks, such as the Internet. In

Peckover, parties may invoke electronic transactions among parties that are authorized

users of the system. Parties may be registered in various roles and capacities to (a) provide information, (b) access information provided by others and conclude commercial transactions. The various parties interact to complete buying and selling transactions.

Persons and organizations may register to become users of the system (for example, Fig. 2 and related text, Col. 15, line 65-Col. 17, line 27). Each party may connect to the network via various types of devices, such as wireless including wireless loops, personal computers, PDA's and other embodiments.

Peckover discloses selecting parties as targets for types of products. For example, see references to Target consumer, Col. 35, line 62-Col. 37, line 41.

Peckover refers to discounts, different prices, Col. 5, lines 1-13. See also special prices to distributors. For example, Col. 16, line 9-Col. 17, line 28. See references to price range. Prices are calculated (including discounts) to produce new prices, including final prices. Final prices are stored in the database as transactions with transaction numbers.

Peckover discloses that parties may download and fill out forms (such as applications for credit) presented by providers of information. Peckover discloses market categories such as real estate (see at least section entitled Market, Col. 22, line 57-Col. 23, line 67 and Col. 37, lines 1-40). Credit includes loans, bonds, charge-account obligation, and others.[3] A loan is a transaction wherein an owner of property

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[3] Definition of credit, Barron's Dictionary of Business Terms.

(lender) allows another party (the borrower) to use the property.[4] A mortgage is a debt

instrument by which a borrower (a mortgagor) gives a lender (mortgagee) a lien on

property as security for the repayment of a loan.[5]

Peckover *does not* specifically disclose

- that purchasing information associated with the data subject includes credit card
  information and shipping information, the shipping information including a shipping
  address and a preferred shipping method

- that new prices are based on shipping address and preferred shipping method

However these differences are only found in the nonfunctional descriptive

material and are not functionally involved in the steps recited. The steps would be

performed the same regardless of the data. Thus, this descriptive material will not

distinguish the claimed invention from the prior art in terms of patentability, see *In re*

*Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32

F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to include credit card and other information from a

customer because such data does not functionally relate to the steps in the method

claimed and because the subjective interpretation of the data does not patentably

distinguish the claimed invention.

Peckover *does not* specifically disclose

- determining whether credit card information is accepted by a merchant.

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[4] Definition of Loan, Barron's Dictionary of Business Terms.

- sending a summary of Consumer transactions to the Consumer.

- sending authorized Merchant transactions to an authorized Merchant..

- sending a transaction confirmation message to the Consumer

Walker discloses purchase confirmation databases, payment databases, sending

transaction data, and confirmation messages in an environment where customers may

present offers, merchants may be authorized and customers may be registered.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Peckover, Walker and knowledge generally available to

one of ordinary skill in the art at the time the invention was made to disclose the claimed

limitations.  One of ordinary skill in the art at the time the invention was made would

have been motivated to combine Peckover, Walker and knowledge generally available

to one of ordinary skill in the art at the time the invention was made to disclose

determining whether credit card information is accepted, sending summaries of

transactions to customers and to merchants, and sending confirmation messages to

customers for the obvious reason that merchants often determine whether to accept

credit cards when making a sale customers often rely on summaries of their

transactions to balance their personal budgets, and merchants rely on summaries of

transactions for auditing purposes.

### *Response to Arguments*

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[5] Definition of Mortgage, Barron's Dictionary of Business Terms.

Applicant's arguments filed 3 September 2003 have been fully considered but they are not persuasive.

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Applicant admits that Peckover "discloses a system for electronic commerce having personal agents that represent consumers and providers in a 'virtual marketplace.'" Nevertheless, applicant argues

> ...Peckover discloses a system which assists users in locating products for sale, but only *anticipates* that the sale may actually be consummated at some point in time in the future, i.e., "when secure electronic transactions are available." Other than this suggestion, Peckover is entirely silent on whether his system may actually be used to purchase items over a network. [emphasis in original]

Electronic commerce is commercial activity that takes place by means of connected computers.[6] The Examiner respectfully notes that applicant appears to avoid discussion of various types of payment mechanisms in electronic commerce. See, for example, Col. 1, line 12-Col. 12, line 41. See also references to invoicing,

An invoice is a bill prepared by a seller of goods or services and submitted to the purchaser; an invoice lists all items bought, together with amounts owed.[7]

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[6] Definition of *Electronic Commerce*, MICROSOFT Computer Dictionary.
[7] Definition of *Invoice*, Barron's Dictionary of Business Terms.

Applicant also argues that Peckover

> ... fails to teach or suggest that an offer and a message may be received from a [consumer] , that the offer may be associated with a [merchant], or that the message may include a network communication device software identifier [cookie].

> ...fails to disclose that purchase transaction information may be sent to the [merchant] in response to a purchase reply received from the [consumer].

In response to these arguments, Peckover specifically describes that

- offers and messages may be received from a consumer. For offers, see at least references to offers to sell and offers to buy, offers to buy in response to advertisements (at least Col. 23, lines 20-30, Col. 26, lines 40-67, Fig. 31 and related text, at least Col. 33, line 50-Col. 34, line 24).

- For messages, see at least references to delivery of messages (Summary, messaging function, Fig. 3A and related text).

- offers may be associated with a merchant. See, for example, references to offers to sell and offers to buy, Fig. 9A and related text, queries associated with7 agents, Fig. 8B and associated text, at least Col. 23, line 63-Col. 24, line19).

- messages may include a cookie. See, for example, Col. 6, lines 26-32. Therefore, applicant's arguments are not persuasive.

## Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*,

ordinary skill in the art to disclose authorizing merchants and other entities.  One of

ordinary skill in the art at the time the invention was made would have been motivated

to combine *Boesch* with knowledge generally available to one of ordinary skill in the art

to disclose authorizing merchants and other entities for the obvious reason that such

authorizing may reduce the number of bogus merchants and reduce the number of false

and invalid offers to customers.

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action.  Accordingly, **THIS ACTION IS MADE FINAL**.  See MPEP

§ 706.07(a).  Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action.  In no event, however, will the statutory period for reply expire later

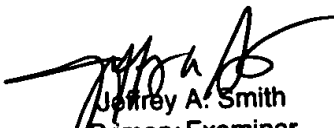than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James H Zurita whose telephone number is 703-605-

4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Wynne Coggins can be reached on 703-308-1344. The fax phone number

for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-306-

1113.

**James Zurita**
**Patent Examiner**
**Art Unit 3625**
5 November 2003

Jeffrey A. Smith
Primary Examiner